

rejected under 35 USC §103(a) as being unpatentable over Shimura in view of U.S. Patent 6,445,818 to Kim et al. Applicants gratefully acknowledge the allowance of Claims 8-17.

As disclosed in the application, two images are determined to be duplicate images if their time of capture is within a certain range and if they have substantially the same content, which is computed from an indication of image content for each image.

Method claims 1 and 2 (and corresponding computer program product claims 18 and 19) stand rejected as being anticipated by Shimura et al. As mentioned above, time of capture is crucial to the evaluation of duplicates, i.e., the further apart the time of capture the less likely are they to be duplicates. Yet, and contrary to the Examiner's suggestions in several places, there is no mention of time in relation to the images of Shimura et al, and in particular no mention of time of capture in relation to such images ("time" appears once in Shimura et al in col. 4, line 41 – in reference to reading one feature at a time, which obviously has nothing to do with the invention). As the Examiner mentions, there is reference to "date of registration" (col. 4, line 5 of Shimura et al), but this clearly refers to the date the image is registered with the disclosed retrieval system shown in Figure 1. It has nothing to do with the time of capture. Moreover, one of ordinary skill in the art would not look to substitute "time of capture" for "date of registration", in part because there is nothing in the disclosed retrieval system that would suggest retrieving an (undisclosed) "time of capture" and nothing that would indicate that it would be interchangeable with "date of registration".

In summary, Shimura et al fails to disclose several crucial components of Applicants' invention: "providing at least two images *captured at determinable times*"; "determining *the time of capture* of each of the images"; and "*evaluating the indication* of image content and *the time of capture* to determine whether the images are duplicate images" (italics added).

It is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention. *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 231 USPQ 81, 90 (Fed. Cir. 1986). Anticipation under 35 U.S.C. Section 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Rockwell International Corp. v. United States*

47USPQ2d 1027, 1031 (Fed Cir. 1998). The foregoing remarks indicate that each rejected claim includes one or more claimed elements that are not to be found or suggested by the Shimura et al reference. For anticipation to be found, all of the claimed elements must be found in Shimura et al. Since that is not the case with respect to each and every one of the claims 1 – 7 and 18 – 24, the Examiner is respectfully asked to withdraw the rejection of these claims under 35 U.S.C. 102(b) and to consider allowance of the claims. Furthermore, claims 3 – 7 and 20 – 24 are therefore believed to be allowable in view of the arguments expressed above in relation to their parent claims 1 and 18, respectively.

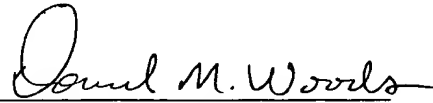
Moreover, the mere fact that a “date of registration” is mentioned in col. 4, line 5 in Shimura et al in close textual association with an input image is not an indication that “time of capture” is inherently interchangeable with “date of registration”, and that “evaluating the indication of .... the time of capture to determine whether the images are duplicate images” is therefore an inherent teaching of the reference. “The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient [to establish inherency.]. *In re Rijckaert*, 28 USPQ2d 1957 (Fed. Cir. 1993) (quoting *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981)). “That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.” *In re Spormann*, 150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newell*, 13 USPQ 2d 1248, 1250 (Fed. Cir. 1989). Such a retrospective view, we believe, is supported only by applicants’ own disclosure of such a novel and unobvious method for detecting duplicate images, and cannot substitute for some teaching or suggestion in Shimura et al. Since there is none, it is our belief that a *prima facie* case has not been established on any theory of inherency.

New claims 25 – 30 are being added to recite the invention in further detail, as disclosed in the specification particularly on pages 4 and 5.

Applicants respectfully request reconsideration of claims 1 – 7 and 18 – 24 in view of these remarks and arguments, which applicants believe make a reasonable case for patentability of the claims.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "**Version with Markings to Show Changes Made**".

Respectfully submitted,

A handwritten signature in cursive script, reading "David M. Woods", written over a horizontal line.

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Version with Markings to Show Changes Made

In the Claims:

Claims 25-30 are new.

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